

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-10 and 12-38 are presently pending. Claims amended herein are 1, 20, 25, 26, and 31. Claims withdrawn or cancelled herein are 11. New claims added herein are none.

### **Statement of Substance of Interview**

**[0004]** The Examiners graciously met with me—the undersigned representative for the Applicant—on November 13, 2007. Applicant greatly appreciates the Examiners’ willingness to talk. Such willingness is invaluable to each of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, we discussed distinctions between the claims and the cited art. Without conceding the propriety of the rejections and in the interest of expediting prosecution, we also discussed several possible clarifying amendments.

**[0006]** The Examiners were receptive to the proposals, and I understood the Examiners to tentatively indicate that proposed clarifying claim amendments regarding “intermediate format” would appear to distinguish over the cited art of record. However, the Examiner indicated that he would need to review the cited art and do another search upon the proposed amendments being presented in writing.

[0007] Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

**Formal Request for an Interview**

[0008] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0009] Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

### **Claim Amendments**

**[0010]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 20, 25, and 26 herein. Applicant amends claims to clarify claimed features in accordance with our discussion with the Examiners. Such amendments are made to expedite prosecution and quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to cited prior art.

### **Formal Matters**

#### **Claims**

**[0011]** The Examiner objects to claim 31 for an informality. Herein, Applicant amends this claim, as shown above, to correct the informality noted by the Examiner.

### **Substantive Matters**

#### **Claim Rejections under §§ 102 and 103**

**[0012]** The Examiner rejects claims 1-5, 7-10, 15-24, and 27 under §102. For the reasons set forth below, the Examiner has not shown that cited reference anticipates the rejected claims.

**[0013]** In addition, the Examiner rejects claims 6, 11-14, 25, 26, and 28-38 under §103. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

**[0014]** Accordingly, Applicant respectfully requests that the § 102 and § 103 rejections be withdrawn and the case be passed along to issuance.

**[0015]** The Examiner's rejections are based upon the following references alone and/or in combination:

- **Comer:** *Comer*, US Patent No. 6,201,927 (iss. Mar. 13, 2001);
- **Miyano:** *Miyano*, US Patent No. 5,694,172 (iss. Dec. 2, 1997);
- **Wilkinson:** *Wilkinson*, US Patent No. 4,689,697 (iss. Aug. 25, 1987);
- **Wang:** *Wang, et al.*, US Patent No. 5,193,004 (iss. Mar. 9, 1993);
- **Thompson:** *Thompson*, US Patent No. 4,661,862 (iss. Apr. 28, 1987);
- **Rault:** *Rault*, US Pat. Pub. No. 2004/0179597 (pub. Sep. 16, 2004);
- **Oura:** *Oura, et al.*, US Pat. Pub. No. 2003/0007556 (pub. Jan. 9, 2003);
- **Peng:** *Peng*, US Patent No. 6,269,117 (iss. Jul. 31, 2001).

### **Overview of the Application**

**[0016]** The Application describes a technology for playing compressed video data and compressed audio data in a reverse direction. A process identifies a most recent key frame received and decodes the most recent key frame. The process then identifies delta frames received after the most recent key frame and decodes these identified delta frames. The decoded delta frames are then played in the reverse direction. The

compressed audio data can be decoded and played in the reverse direction along with the video data.

### **Cited References**

**[0017]** The Examiner cites Comer as the primary reference in anticipation- and/or obviousness-based rejections. The Examiner alternately cites Miyano or Wilkinson or takes Official Notice as a secondary reference in obviousness-based rejections. The Examiner cites Peng as a tertiary reference in obviousness-based rejections. The Examiner alternately cites a combination of Wang and Thompson, and Rault and Oura as a secondary and tertiary reference in obviousness-based rejections.

#### **Comer**

**[0018]** Comer describes a technology for reproducing a digitally encoded signal. The apparatus comprises a decoding means for decoding the digitally encoded signal to form a specific picture. A memory means is coupled to the decoding means for storing the specific picture. A control means is controllably coupled to the memory means, wherein a first mode the control means controls the memory means for storing a frame of the specific picture and responsive to a second mode the control means controls the memory means for storing only one field of the specific picture.

#### **Miyano**

**[0019]** Miyano describes a technology for reproducing picture data including a variable length decoder and Huffman decoder, an inverse discrete cosine transformer (IDCT) coupled to the Huffman decoder, an intra-frame unit for prediction and motion

compensation coupled to the IDCT, a memory coupled to the intra-frame unit, a buffer memory coupled to an output of the intra-frame unit, a resolution changer coupled to the buffer memory, a frames in/out unit coupled to the output of the resolution changer; a unit for changing the picture frame time table coupled to the output of the frames in/out unit, a frame memory coupled to the changing unit, and a selector for selecting picture data for reproduction from the buffer memory or the changing unit.

Wilkinson

**[0020]** Wilkinson describes a technology for reproducing digital audio data which have been recorded in oblique tracks on a magnetic tape in association with digital video data, the audio data in each track having been assembled as blocks of audio data words for recording, and the audio data words having been shuffled in order over a predetermined distance greater than one block prior to recording. In the method, in a slow motion reproduction mode, the recorded audio data is reproduced at a speed lower than the normal reproducing speed, and on a first occasion that any given block of audio data words is reproduced in complete form, that block of audio data words is stored, and each stored block of audio data words is read out under control of a read clock signal the frequency of which is adjusted to correspond to the reproduction speed, whereby the audio data is reproduced with a change in pitch. In a fast motion reproduction mode fragments of the audio data are reproduced without a change in pitch.

Wang

**[0021]** Wang describes a technology for coding multi-mode predictive interpolative coded fields of video, including the steps of: (a) providing a current field of interlaced pixel data, and past and future fields of such data; (b) providing estimated pixel

data at omitted line positions in the past and future fields of data to form enhanced fields of pixel data; (c) comparing a block of pixel data from the current field with corresponding blocks of data from such past and future fields to derive motion vector signals indicative of best matched blocks of data; (d) developing pixel error signals representing pixel by pixel errors based on utilization of best matched blocks in different modes for comparison with the block of pixel data from the current field and developing best mode signals indicative of which of such modes represents the least overall error; and (e) providing the best mode signals, motion vector signals, pixel error signals, and the future odd field of data for transmission for use by a decoder.

Thompson

**[0022]** Thompson describes a technology for a wide-aspect-ratio HDTV signal having 1600 luminance pixels/32 .mu.S line and 980 lines/frame is data reduced by deleting odd pixels of each line of TV field #1 and even pixels of each line of TV field #2 to produce 800 pixels per line, and is further data compressed by a form of differential-pulse-code modulation. The DPCM organizes the pixels into groups of five, and for each group transmits or records one reference pixel at full N-bits. The pixels to the right and left of the reference pixel are compared therewith to produce difference signals of M bits, where  $M < N$ . The remaining two pixels of each group are compared with reference pixels from the lines above and below to form M-bit difference signals. The difference signals are transmitted. The DPCM coding reduces the 800 pixels/line to the equivalent of 480 pixels/line. The color portion of the wide-aspect-ratio HDTV is similarly coded to produce the equivalent of 240 pixel/line. The 480 luminance samples and 240 color samples are added to form 720 samples/line, or 1440 samples/64 .mu.sec which can be accommodated by a CCIR-standard-601 signal processing system.

Rault

**[0023]** Rault describes a technology for transcoding video data that generates a motion vector for a macroblock encoded as a dual prime macro block that has a direct motion vector, and differential motion vector for its two fields respectively. Another method of transcoding includes replacing a skipped P-macroblock that has been used to backward predict a B-Frame with a P-macroblock having a motion vector of zero. Another method of transcoding includes replacing a skipped B-Macroblock with a macroblock having a motion vector from a macroblock of the same frame of the skipped B-Macroblock that is not co-located.

Oura

**[0024]** Oura describes a technology for in a mobile terminal provided with an encoded data recording function, there is assumed a condition in which a picture frame transmitted from the terminal of a communication partner is reproduced by means of decoding processing and is displayed on a LCD during wireless TV phone communication. In this condition, when a user carries out a picture recording start operation, display picture data reproduced by means of decoding processing in the multimedia processing section to be displayed on the LCD are recorded in a main recording section.

Peng

**[0025]** Peng describes a technology for an enhanced downsampling operation for digital data. In the preferred embodiment, a downsampling filter has a quantity of filter coefficients equal to  $4(a)+1$ , where  $(a)$  is an integer. In this case the even-numbered coefficients are, to the degree of accuracy required, equal to zero. Also the central even-



numbered coefficient is equal to 1/2. As multiplication by 1/2 in a binary digital system may be executed by a simple right shift, the total number of coefficient-sample multiplications may be reduced to 2(a). The filter design wherein the even-numbered coefficients equal zero also has the additional benefit of reducing the number of storage locations for the filter coefficients. A further aspect of the present invention is the segregation of the input data stream into even and odd-numbered sample buffers.

### **Anticipation Rejections**

**[0026]** Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

### **Based upon Comer**

**[0027]** The Examiner rejects claims 1-5, 7-10, 15-24, and 27 under 35 U.S.C. § 102(b) as being anticipated by Comer. Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of this claim.

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<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see *MPEP* §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent Claim 1

**[0028]** The Examiner indicates (Action, p. 2) the following with regard to this claim:

Regarding claim 1, Comer discloses a method comprising: receiving a request to play compressed video data in a reverse direction (column 2, lines 54-56); identifying a most recent key frame received (column 2, lines 57-60; Fig. 1B; Fig. 2); decoding the most recent key frame (column 2, lines 57-63; Fig. 2); identifying delta frames received after the most recent key frame (Fig. 2; column 3, lines 22-31); decoding the identified delta frames (Fig. 2; column 3, lines 22-31); and playing the decoded delta frames in the reverse direction (Fig. 1B; Fig. 2; column 3, lines 32-51).

Dependent Claim 15

**[0029]** The Examiner indicates (Action, p. 4) the following with regard to this claim:

Regarding claim 15, Comer also discloses decoding the most recent key frame includes partially decoding the most recent key frame to an intermediate format (column 11, lines 11-61; Fig. 7).

**[0030]** Applicant submits that Comer does not anticipate claim 15 because it does not show or disclose the following elements as recited in this claim (with emphasis added):

- “wherein decoding the most recent key frame includes **partially decoding the most recent key frame to an intermediate format**”

**[0031]** In this Action, the Examiner equates the various fields of the picture being decoded disclosed by Comer with the “partially decoding the most recent key frame to an intermediate format” recited in this claim. Applicant respectfully disagrees.

**[0032]** Unlike the “partially decoding the most recent key frame to an intermediate format” of the claim, the various fields of the picture being decoded of Comer is not characterized as being partial decoding resulting in an “intermediate format.” The various fields of the picture being decoded of Comer indicate that some fields of Comer’s picture will be discarded while others are stored.

**[0033]** Consequently, Comer does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

## **Obviousness Rejections**

### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

**[0034]** Applicant disagrees with the Examiner’s obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

### **Based upon Comer and Official Notice**

**[0035]** The Examiner rejects claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Comer in view of taking Official Notice. Applicant respectfully traverses the rejection of this claim and asks the Examiner to provide evidence that

“decoding the most recent key frame includes decompressing the most recent key frame” as claimed.

**[0036]** The Examiner states “It is well known in the art that decoding [sic] compressed MPEG frame must comprise decompressing. Therefore, Official Notice is taken.” As decoding and decompressing are two separate actions, Applicant respectfully requests evidence supporting the Examiner’s statement of Official Notice.

**Based upon Comer, Wang, and Thompson**

**[0037]** The Examiner rejects claims 11, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Comer in view of Wang and Thompson. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

**Independent Claim 1**

**[0038]** Herein Applicant amends claim 1 to include the subject matter of former claim 11 (now cancelled). The Examiner indicates (Action, p. 7) the following with regard to claim 11:

Regarding claim 11, see the teachings of Comer as discussed in claim 1 above.

Comer also discloses deleting fields of each decoded delta frames (column 11, lines 53-61). However, Comer does not disclose deleting alternating rows of pixels in each decoded delta frame and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame.

Wang et al. disclose deleting either odd or even fields, each of which includes alternating rows of pixels, in each frame (column 1, lines 10-15).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the step of deleting alternating rows of pixels as disclosed by Wang et al. into the method disclosed by Comer to reduce the bandwidth of the signals. The incorporated feature would speed up processing and fast playback.

However, the proposed combination of Comer and Wang et al. does not disclose deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame.

Thompson discloses deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame (abstract).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the step of deleting alternating pixels in non-deleted rows of pixels as disclosed by Thompson into the method disclosed by Comer and Wang et al. to further reduce the bandwidth of the signals. The incorporated feature would further speed up the processing and fast playback. Also it would make the method compatible with display device with less resolution.

The Examiner acknowledges that Comer does not teach the “deleting alternating rows of pixels in each decoded delta frame; and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame,” as recited in this claim. The Examiner therefore relies on Wang, which teaches coding via “downsampling the interlaced video sequence by deleting either all the even or all the odd fields,” (c. 1, ll. 13-15). The Examiner states that each field of Wang includes alternating rows of pixels, in each frame. However, the claim is not directed to *coding* via “deleting either all the even or all the odd fields” as taught by Wang. Rather, what is claimed (with emphasis added) is:

**“ . . . decoding the identified delta frames; . . . deleting alternating rows of pixels in each decoded delta frame; and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame.”**

**[0039]** The Examiner then acknowledges that neither Comer nor Wang teach “deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame” as recited in the claim. The Examiner next relies on Thompson which teaches encoding via “deleting odd pixels of each line of TV field #1 and even pixels of each line of TV field #2 [and the signal is] further data compressed,” (Abstract). However, the claim is not directed to *encoding via deleting odd pixels of the lines of one TV field and even pixels of the lines of another TV field*. Rather, what is claimed (with emphasis added) is: “. . . **decoding the identified delta frames; . . . deleting alternating rows of pixels in each decoded delta frame; and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame.**”

**[0040]** Comer neither teaches nor suggests “. . . decoding the identified delta frames; . . . deleting alternating rows of pixels in each decoded delta frame; and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame.” None of the myriad of additional cited references remedies this deficiency of Comer. Thus, for at least this reason, Applicant respectfully submits that this claim is not obvious and respectfully requests that this rejection be withdrawn, and this matter passed along to issuance.

Independent Claim 20

**[0041]** Herein Applicant amends claim 20 to include the subject matter of former claims 25 and 26 and additional clarifying features from claims 12, 14 and 30. The Examiner indicates (Action, pp. 4-5) the following with regard to claim 20:

Regarding claim 20, Comer discloses a method comprising: receiving a request to play compressed video data in a reverse direction (column 2, lines 54-56); identifying a most recent key frame previously received (column 2, lines 57-60; Fig. 1B; Fig. 2); decoding the most recent key frame (column 2, lines 57-63; Fig. 2); identifying delta frames received subsequent to the most recent key frame (Fig. 2; column 3, lines 22-31); decoding the identified delta frames (Fig. 2; column 3, lines 22-31); deleting N of P delta frames, wherein N and P are integers (In Fig. 8A, 10 frames are deleted out of 12 frames from display as shown in the display sequence); and playing the remaining identified delta frames in the reverse direction (Fig. 8A).

**[0042]** The Examiner indicates (Action, p. 8) the following with regard to claim 12:

Regarding claim 12, see the teaching of Comer as discussed in claim 1 above. However, Comer does not disclose reducing an amount of data associated with each pixel in each decoded delta frame; and storing the reduced amount of data associated with each decoded delta frame.

Miyano discloses reducing an amount of data associated with each pixel in each decoded delta frame (column 4, lines 28-33); and storing the reduced amount of data associated with each decoded delta frame (column 4, lines 48-51).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the steps of reducing an amount of data associated with each pixel in each decoded delta frame; and storing the reduced amount of data associated with each decoded delta frame as disclosed by Miyano into the method disclosed by Comer to reduce the bandwidth of the signals. The incorporated feature would speed up the processing and fast playback. Also it would make the method compatible with display device with less resolution.



**[0043]** The Examiner indicates (Action, p. 10) the following with regard to claim 14:

Regarding claim 14, see the teachings of Comer as discussed in claim 1 above. Comer also discloses identifying at least one compressed audio packet associated with the compressed video data (column 4, lines 55-58; column 5, lines 28-36); decoding the compressed audio packet (column 5, lines 40-42); and playing the decoded audio packet (column 5, lines 42-45). However, Comer does not disclose playing the audio packet in reverse order. Comer only discloses playing the decoded video in reverse order (Fig. 1B; Fig. 8A; column 3, lines 32-54).

Wilkinson discloses playing audio packet in reverse order (column 7, lines 19-28).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate playing the audio packets in reverse order disclosed by Wilkinson into the method disclosed by Comer so that the audio is synchronized and consistent with scenes presented by the video data when they are played back in the reverse order because playing audio in forward direction while playing the video in reverse direction would make the audio irrelevant and annoying.

**[0044]** The Examiner indicates (Action, pp. 13-14) the following with regard to claim 30:

Regarding claim 30, see the teachings of Comer and Wilkinson as discussed in claim 28 above. Further, Comer also discloses the reverse playback controller discards alternating frames of received video data (In Fig. 8A, for GOP B, P(19) is not deleted

while P(16) and P(22) are deleted and not displayed as shown in the display sequence). However, the proposed combination of Comer and Wilkinson does not disclose the reverse playback controller does the operation of discarding alternating frames of received audio data.

Peng discloses the operation of discarding alternating frames of received audio data (column 9, lines 51-53; column 5, lines 8-12).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the operation of discarding alternating frames of received audio data as disclosed by Peng into the reverse playback controller to lower the sample rate of the audio during a fast reverse playback. The incorporated feature is necessary to keep the audio in sync with the video during a fast reverse playback. It also helps speed up the processing and outputting because of low bandwidth.

**[0045]** The Examiner acknowledges that Comer does not teach each of the features recited in these claims. The Examiner relies on Wang, Thompson, Miyano, Wilkinson, and Peng to remedy the deficiency of Comer.

**[0046]** Applicant respectfully disagrees and traverses the rejections of these claims. Applicant submits that the myriad of references does disclose each of the features of claim 20 and for at least the reasons presented regarding claim 1 above requests that the rejection of claim 20 be withdrawn.

Independent Claims 28 and 33

**[0047]** Applicant respectfully disagrees with and traverses the rejections of these claims. Applicant submits that the myriad of cited references does disclose each of the

features of claims 28 and 30 and for at least the reasons presented regarding claim 1 above requests that the rejections of these claims be withdrawn.

No Reason to Combine References

**[0048]** Regarding claim 11, the Examiner admits that Comer does not teach “. . . decoding the identified delta frames;. . . deleting alternating rows of pixels in each decoded delta frame; and deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame,” as recited in this claim. The Examiner does not state that it would be obvious to combine the teaching of Comer with the either of the teachings of Wang or Thompson. Rather, the Examiner states that “One of ordinary skill in the art at the time the invention was made would have been motivated to *incorporate*” a step from Wang into the method disclosed by Comer and further *incorporate* a step from Thompson. However, the Examiner provides no evidence of the level of “one of ordinary skill in the art.”

**[0049]** Without agreeing or disagreeing regarding any of the cited references disclosing what they are purported to disclose, Applicant notes that, for example, *coding via deleting either all the even or all the odd fields and encoding via deleting odd pixels of the lines of one TV field and even pixels of the lines of another TV field* is not what is claimed.

**[0050]** It appears that Applicant's disclosure provided the reason to attempt to combine the cited references; however, at least since none of the above references teach or suggest all of the elements of these claims, there exists no reasonable evidence to combine these references in this way.

**[0051]** “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” KSR Int’l Corp. v. Teleflex, Inc., Slip Op. at 14 (U.S. Apr. 30, 2007) (quoting In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006)).

**[0052]** Applicant submits that Examiner has not identified some suggestion, teaching, or reason from the cited references themselves (or from the knowledge of one of ordinary skill in the art) that would have led one of ordinary skill in the art at the time of the invention (hereinafter, “OOSA”) to combine the disclosures of the cited references in the manner claimed. More specifically, there is no motivation to combine because:

- although some of the references can be combined or modified, the cited art does not suggest the desirability of such combination/modification;
- the Examiner has not provided any objective and particular evidence showing why OOSA would be motivated to combine the teachings of the two references.

**[0053]** Accordingly, the Applicant therefore respectfully asks the Examiner to withdraw the rejections of these claims.

*No Reasonable Evidence to Combine: Cited References Express no Reason to Combine*

**[0054]** Applicant submits OOSA would have no reason to combine the teachings of Comer and Wang and Thompson because none of the reference expresses a reason to combine the teachings of these references, either explicitly or implicitly.

**[0055]** Applicant submits that because Comer discloses storing only one field of a specific picture, but does not suggest deleting pixels from the field, OOSA would have no reason to look to Wang or Thompson.

**[0056]** The above statement is draws on the reasoning of the BPAI presented in *Ex parte Rinkevich* (non-precedential decision) on May 29, 2007.

**[0057]** In its reasoning, the BPAI stated: “[a] factfinder should be aware, or course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning,” (quoting *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also* *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474). In that case, as in the matter as issue here, the Applicant raised the issue of improper hindsight reasoning. Therein the BPAI was persuaded that the problem or deficiency that the Examiner raised as motivation to seek out a secondary reference, “impermissibly used the instant claims as a guide or roadmap in formulating the rejection.” The BPAI further quoted the Supreme Court in *KSR* stating that “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it,” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. Applying common sense to the case at hand, the BPAI concluded that “a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill,” (emphasis provided). Ultimately the BPAI found that the Examiner had impermissibly used the claims has a guide to formulate the rejection.

**[0058]** As in *Ex parte Rinkevich*, Applicant submits OOSA would have no reason to combine the teachings of Comer with Wang and Thompson because the references do

not express a reason to combine the teachings of these references, either explicitly or implicitly.

**[0059]** At p. 7 of the Action, the Examiner suggests that the reason to combine the teaching of Comer and Wang is that Wang teaches deleting fields “each of which includes alternating rows of pixels, in each frame.” However, Wang does not teach “each of which includes alternating rows of pixels, in each frame.” Wang teaches deleting fields, and because Comer already addresses deleting fields (“storing only one field,” Abstract), OOSA *having common sense* would not have reasonably looked to Wang for such teaching since Comer had already addressed the problem.

**[0060]** Additionally, at p. 7 of the Action, the Examiner suggests that the reason to combine the teaching of Comer and Wang and Thompson is that Thompson teaches “deleting alternating pixels in non-deleted rows of pixels in each decoded delta frame,” and incorporating this “feature would further speed up the processing and fast playback.” However, because Comer already addresses deleting fields (“storing only one field,” Abstract) and fast playback (“reverse three times speed” c.2, l. 55), and Thompson does not, OOSA *having common sense* would not have reasonably looked to Thompson for such teaching since Comer had already addressed the problem.

**[0061]** Similar to *Ex parte* Rinkevich, Applicant submits OOSA would have no reason to combine the teachings of Comer and Wang and Thompson because the references do not express a reason to combine the teachings of these references, either explicitly or implicitly.

**[0062]** For the foregoing reasons, Applicant submits that none of the references express a reason to combine the teachings of these references. Accordingly, OOSA would have no reason to combine the teachings of the cited references.

*No Reason to Combine: No Showing of Objective Evidence*

**[0063]** Furthermore, Applicant respectfully submits that the Examiner has not met his burden in showing a reason to combine Comer and Wang and Thompson and Miyano and Wilkinson and Peng. More specifically, as discussed above regarding Comer and Wang and Thompson, the Examiner has not identified any objective and particular evidence found in the cited references that show why OOSA would reasonably look to combine the teachings of each of the cited references.

**[0064]** In light of *Ex parte* Rinkevich, the Examiner has not identified any specific portion of the cited references as being objective and particular evidence that would have prompted OOSA to look towards the teachings of the other to produce the combination of references that the Examiner proposes. Applicant respectfully submits that the Examiner cannot maintain the obviousness-based rejections without pointing out, with particularity, the specific portions of the cited references that would have prompted OOSA to look towards the teachings of the other to produce the combination of references that the Examiner proposes.

**[0065]** For the foregoing reasons, Applicant submits that the Examiner has not met his burden in showing objective evidence to combine references. Accordingly, OOSA would have no reason to combine the teachings of cited references.

**[0066]** In sum, Applicant submits that there is no suggestion or teaching given by one reference that would prompt OOSA to combine it with the teachings of the other reference. More specifically, there is no reason to combine because no rationale exists in the references themselves to make the combination; and the Examiner has not provided any objective and particular evidence showing why OOSA would have a reason to combine the teachings of the two references.

**[0067]** As shown above, the combination of Comer and Wang and Thompson and Miyano and Wilkinson and Peng and Rault and Oura does not disclose all of the claimed elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

*Dependent Claims 2-1, 12-19, 21-27, 29-32, and 34-38*

**[0068]** These claims ultimately depend upon independent claims 1, 20, 28, and 33. As discussed above, claims 1, 20, 28, and 33 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons. Applicant respectfully requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.



**Expectation that the Next Action will not be Final**

**[0069]** Applicant submits that all pending claims are in condition for allowance. If the examiner feels otherwise and believes that another action on the merits is necessary, then Applicant expects such an action would be Non-Final.

**[0070]** According to 37 CFR § 1.113 and MPEP 706.07, the “examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” “The invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied.”

**[0071]** In accordance with 37 CFR § 1.113 and MPEP 706.07(a), Applicant respectfully submits that finality would be premature for the next action because for the following reasons:

- The Applicant did not amend each independent claim in a manner that necessitates that the Examiner perform a new search or introduce a new ground of rejection;
- This Office Action failed to provide specific claim rejections and/or reasoning for those rejection.

No Action necessitating new grounds for rejection or new search

**[0072]** Herein, Applicant does not and has not amended independent claims 28 or 33. Furthermore, the amendments to claim 1 are limited to incorporating the recitation of dependent claim 11 (or are of substantially the same subject matter). Consequently, one or more claims presented herein have already been examined in the Office Action. Furthermore, Applicant explains herein why these already-examined claims differ from the cited art of record. Therefore, in accordance with 37 CFR § 1.113 and MPEP 706.07(a), finality for the next action would be premature.

Applicant's Right to Adequately Respond

**[0073]** With few exceptions, the Examiner provides little to no explanation as to how the components of the cited reference correspond to the actual claim language. Furthermore, the Office provides little or no explanation as to how the operation of components of the cited reference corresponds to that of the actual claim language.

**[0074]** Since the Examiner has provided little reasoning for the rejections, Applicant can do little more than gainsay. Applicant is forced to make assumptions and guesses as to the Examiner's specific reasoning. Therefore, Applicant submits that it has been denied its right to adequately and effectively respond to the Office's rejections.

**[0075]** In *In re Lee*, 61 USPQ2d 1430 (CA FC 2002), the Federal Circuit explained the following on page 1433:

The Administrative Procedure Act, which governs the proceedings of administrative agencies [such as the Patent and Trademark Office] and related judicial review, establishes a scheme of "reasoned decisionmaking." Not only must an agency's decreed result be within the scope of its lawful

authority, but the process by which it reaches that result must be logical and rational. Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 374 (1998) (citation omitted).

This standard requires that the agency not only have reached a sound decision, but have *articulated the reasons for that decision*. The reviewing court is thus enabled to perform meaningful review within the strictures of the APA, for the court will have a basis on which to determine “whether the decision was based on the relevant factors and whether there has been a clear error of judgment.” *Citizens to Preserve Overton Park v. Volpe*, 401 U.S. 402, 416 (1971). [emphasis added]

**[0076]** Applicant submits that the Office has not articulated the reasons for its decision-making here. Furthermore, according to the reasons and facts given above and to 37 CFR § 1.113 and MPEP 706.07, Applicant respectfully submits that no clear issues has been developed between the applicant and the examiner for each pending claim so that such issues would be ready for appeal if the next action is made final. Accordingly, Applicant respectfully requests that the next action—if not a Notice of Allowance—be Non-Final.

### **Conclusion**

**[0077]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Respectfully Submitted,

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